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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,242	05/18/2005	Susumu Muto	P26130	2371

7055	7590	12/18/2007
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EXAMINER	
VALENROD, YEVGENY	

ART UNIT	PAPER NUMBER
1621	

NOTIFICATION DATE	DELIVERY MODE
12/18/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
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Office Action Summary	Application No.	Applicant(s)	
	10/510,242	MUTO ET AL.	
	Examiner	Art Unit	
	Yevgeny Valenrod	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 20-23 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-17, 24 and 25 is/are rejected.
- 7) ☒ Claim(s) 18 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Restriction requirement

The restriction requirement between groups I and II has been made final in the office action dated 4/9/07. Rejoinder of claims 20-23 will be granted once all of the pending product claims are deemed allowable.

Response to applicants' amendment

Rejection of claims 1-10, 12-17, 24 and 25 under 35 USC 102 as being anticipated by Marsilje et al, Stein et al and Butenas et al. is withdrawn in view of applicants' amendment.

Rejection of claims 1-10, 12-19 and 24-25 under 35 USC 112, second paragraph, is withdrawn in view of applicants' amendment.

Rejection of claims 1-9 and 12-19 under 35 USC 112, second paragraph, is withdrawn in view of applicants' amendment

Rejection of claims 1-9 and 12-19 under 35 USC 112, first paragraph is withdrawn in view of applicants' remarks.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

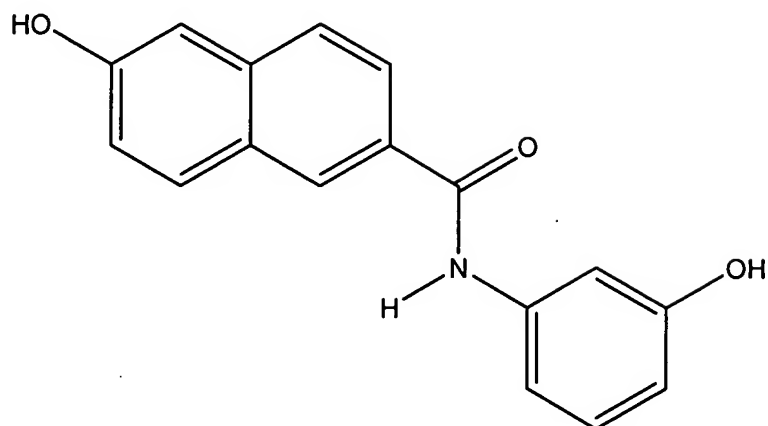
the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2, 5-10, 12-13, 16, 17, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsilje et al. (Bioorganic & Medicinal Chemistry Letters 2000, 10, pp 477-481; already of record).

Scope of prior art

Marsilje et al. teach compound **2v** on page 478. Said compound the following structure:



The above structure corresponds to compounds of the instant invention as follows:

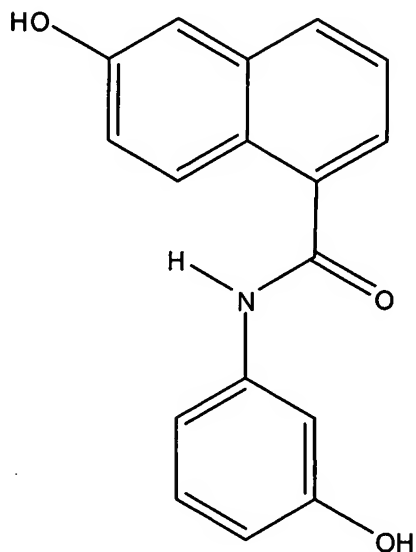
Ascertaining the difference between prior art and instant claims

The compound disclosed by Marsilji et al. differs from the compounds of the instant invention in the location of substituents on naphthalene.

Obviousness

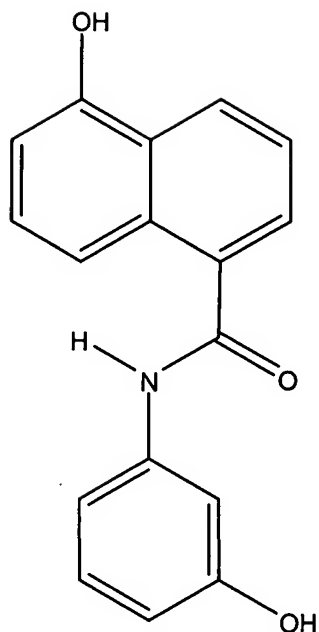
The following compounds within the scope of the instant claims are rendered obvious by compound **2v** taught by Marsilji et al.:

1)



Claims: 1, 2, 6-10, 12-13, 17, 24 and 25

AND



Claims 5 and 16

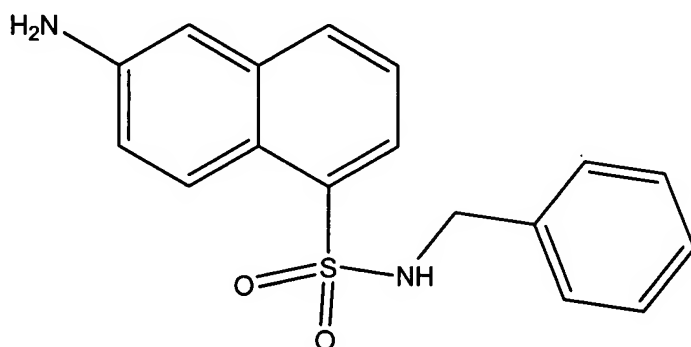
The above compounds differ from compound **2v** taught by Marsilji et al in the positioning of the ring substituents. "Compounds which differ only in the placement of substituents in a ring is not patentable absent unexpected results". In re Jones, 162 F.2d 638, 74 USPQ 152 (CCPA 1947).

Limitations of claims 1, 2, 6-9, 12, 13 and 17 that are directed to enhancing the effect of cancer treatment recite an intended use and are not considered as further limiting. "It is well settled that the intended use of a composition or product (e.g. as a cosmetic composition) will not further limit claims drawn to a composition or product, so long as the prior art discloses the same composition comprising the same ingredients in an effective amount as instantly claimed" See, e.g., *Ex parte Masham*, 2 USPQ2d, 1647.

Claims 1-10, 12-16, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butenas et al. (Biochemistry 1992, 31, pp 5399-5411; already of record).

Scope of prior art

Butenas et al. teach a compound of the following formula:

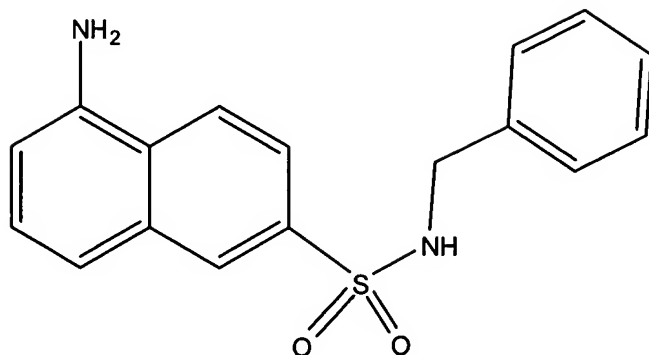


Ascertaining the difference between instant claims and prior art

The compound taught by Butenas et al. differs from the instantly claimed compounds in the ring position of the substituents.

Obviousness

The following compound, within the scope of the instant claims, is rendered obvious by the compound taught by Butenas et al.:



The above compound differs from the compound disclosed by Butenas et al. in the positioning of the substituents on the ring. "Compounds which differ only in the placement of substituents in a ring is not patentable absent unexpected results". In re Jones, 162 F.2d 638, 74 USPQ 152 (CCPA 1947).

Claims that are directed to a medicament are treated as claims with an intended use for the compound and the intended use is not given patentable weight.

"It is well settled that the intended use of a composition or product (e.g. as a cosmetic composition) will not further limit claims drawn to a composition or product, so long as the prior art discloses the same composition comprising the same ingredients in an effective amount as instantly claimed" See, e.g., *Ex parte Masham*, 2 USPQ2d, 1647.

Claim objections

Claims 18 and 19 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Allowable subject matter

Claim 11 is allowed for reasons of record.

Conclusion

Claims 1-25 are pending.

Claims 1-10, 12-17 and 24-25 are rejected.

Claims 18 and 19 are objected to.

Claims 20-23 are withdrawn.


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yevgeny Valenrod whose telephone number is 571-272-9049. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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